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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,223	11/20/2001	David Lawrence Kelly	032885-71	9694

7590 01/30/2004

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,223

Applicant(s)

KELLY ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 25-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 9-14, 17 and 20-24 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 7, 8, 15, 16, 18 and 19 is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) = .

- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. The disclosure is objected to because of the following informalities:

The use of the trademarks KRANTON, HYTREL, and PEBAX (specification p. 10) has been noted in this application. These trademarks should be capitalized in the specification.

Appropriate correction is required.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24, drawn to an apparatus for use in embedding an anchor in a concrete structure, classified in class 249, subclass 91.

- II. Claims 25-26 and 29-30, drawn to a method for embedding an anchor in a concrete structure, classified in class 264, subclass 278.

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III. Claims 27-28, drawn to a method of forming a hollow body for a concrete void former, classified in class 29, subclass 434.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions Group II and Group I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as a process wherein a hollow body is embedded into a concrete structure by injecting aerated or foam concrete about the hollow body positioned in a mold.

Inventions Group II and Group III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group II has separate utility such as being used to mold hollow body by a process other than injection molding, such

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as the body being formed by a thermoforming molding process.

MPEP § 806.05(d).

Inventions Group III and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as a process not using injection molding to form the body, rather the body being formed by a thermoforming molding process.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation between Examiner Micheal Poe and John Uileme (Applicants' Representative) on January 16, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-24. Affirmation of this election must be made by applicant in replying to this Office

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action. Claims 25-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2, 11-13, and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Fricker (U.S. Pat. No. 4,383,674; previously of record; hereinafter "Fricker '674").

Fricker '674 discloses a combination of an anchor (50) for lifting a concrete structure and an apparatus (10) for placing

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the anchor in a form for the structure and forming a void partially therearound (figure 1). The apparatus comprises a body (40) having first and second sections hinged together at upper portions thereof for movement between a closed condition in which the sections engage around the anchor and an open condition in which the sections are separated at the lower portion thereof to release the anchor (col. 4, ll. 34-46). A passage (between flanks 44 and 45) is defined between the sections, the passage complementally receiving the anchor and opening through an underside of the body to permit the anchor to extend from the undersurface (figure 2). The body, upon movement of the first and second sections to the open position, is disposed to release the anchor from the body (col. 4, ll. 41-46).

The apparatus of Fricker '674 also comprises a latch (211 and 311) disposed between the sections to releasably section the sections in the closed condition (note, col. 4, ll. 23-33 disclosing that the sections are forcibly aligned by structures 211 and 311, thus these structures form a latch securing the sections together in the closed condition). The latch is disposed beneath the upper portions of the sections and in part beneath the passage (figure 2). Fricker '674 further discloses

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guide elements (21 and 31) which engage when the sections are moved to the first condition (col. 4, ll. 27-29).

Fricker '674 discloses the anchor to be of a generally plate-shape configuration (figures 1) having a portion complementally received within an upper portion of the passage and an opening (51) extending therethrough which the latch extends when the sections are in the closed condition (figures 2 & 4). While being in a generally plate-shaped configuration, the anchor is also formed in an angle shape by the two opposite facing parts at the end of the anchor opposite the end set in the body (see figure 1).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 3, 6, 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fricker '674 in view of Fricker (U.S. Pat. No. 4,821,994; previously of record; hereinafter "Fricker '994").

Fricker '674 discloses the apparatus as described above.

Fricker '674 further discloses the body (40) of the apparatus tp

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be hollow and formed of a flexible polymeric material (col. 4, l. 62 - col. 5, l. 1). The body (40) comprises a monolithic shell (figure 2) defining the first and second sections. Fricker '674 also discloses the hinge of the apparatus comprises bridge elements (41) monolithically formed with and extending between upper portions of the first and second sections (figure 3).

Fricker '674 does not disclose a cap secured over the shell of the body to provide a closure therefor.

Fricker '994 discloses a void forming apparatus for use in embedding an anchor in a concrete structure. A cap (5) is provided over the shell of the void forming body (1) for the purpose of closing the inside of the body and aiding in retention of the body to formwork (col. 1, l. 64 - col. 2, l. 4).

It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the apparatus of Fricker '674 as such to have provided a cap secured over the shell of the body because such a cap would close the inside of the body as well as aid in retaining the body to formwork as suggested by Fricker '994.

13. Claims 9-10 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fricker '674 modified by Fricker '994

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as applied to claims 3, 6, 14, and 17 above, and further in view of Langkamp et al. (U.S. Pat. No. 5,792,552).

Fricker '674 and Fricker '994 disclose and suggest the apparatus as described above. Fricker '674 and Fricker '994 both disclose the body of the apparatus to be made from polyurethane (Fricker '674 at col. 4, l. 65 - col. 7, l. 1 and Fricker '994 at col. 2, ll. 9-18). Fricker '674 suggests such a material because of its flexibility (col. 4, ll. 67-68), and Fricker '994 suggests such a material because of its resistance to the chemical and physical effects of the concrete or formwork materials (col. 2, ll. 12-15).

Neither Fricker '674 nor Fricker '994 suggest polymeric material for the body be a polymer selected from the group consisting of styrenic copolymer, polyester elastomer, polyethylene, nylon, polyether block amide, styrene butadiene copolymer, EPDM rubber, and polypropylene copolymer.

Langkamp discloses an apparatus for use in the molding of concrete structures. Langkamp discloses several different materials for use in the formation of the apparatus including polyester elastomers (col. 9, ll. 54-62), polyethylenes (col. 13, ll. 51-58), nylon (col. 13, ll. 43-50), polyetherimides (col. 9, ll. 54-62), styrenic copolymers such as styrene-butadiene copolymers (col. 11, ll. 38-49), EPDM rubbers (col.

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11, ll. 38-49), and polypropylene copolymers (col. 11, ll. 38-49). Langkamp notes that the disclosed polymers provide superior mechanical properties for the apparatus (col. 9, ll. 54-56).

It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the apparatus of Fricker '674 and Fricker '994 to have used a polymeric material selected from the group consisting of styremic copolymer, polyester elastomer, polyethylene, nylon, polyether block amide, styrene butadiene copolymer, EPDM rubber, and polypropylene copolymer in alternative to the polyurethane because these polymers have the superior mechanical properties necessary for a concrete structure forming apparatus as suggested by Langkamp.

14. Claims 4-5, 7-8, 15-16, and 18-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest an apparatus for use in embedding an anchor in a concrete structure

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with the combination of features recited in claims 4, 7, 15, and 18. The closest prior art disclosed by Fricker '674 and Fricker '994 is described above. Fricker '674, while teaching a type of latching mechanism, does not teach or suggest the latch to comprise a catch integrally formed with the first section of the body and an opening integrally formed with the second section for latching engagement with the catch as defined in claims 4 and 15. The combination of Fricker '674 and Fricker '994 suggest a cap for use in the apparatus as described above, however, the references do not teach or suggest the hinge to comprise second bridge elements integrally formed with and extending between separate sections of the cap as defined in claims 7 and 18.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (571) 272-1151. The official fax phone number for

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the organization where this application or proceeding is
assigned is (703) 872-9306.



~~Donald Heckenberg~~
~~January 22, 2004~~